

Serial No.: 10/506,312
Docket No.: X-15664

REMARKS

Claims 1-33 are in the application. Claims 1, 5, 9, 12, 15, 18, and 26 have been amended to delete the recitation of CP1.

Examination of the present application in view of the present amendments and remarks is respectfully requested.

The Restriction Requirement

The Examiner has required restriction of the present claims under 35 U.S.C. §§121 and 372 to one of the following inventions:

- Group I:** Claims 1-8, drawn to methods of inhibiting the maturation of an antigen presenting cell *in vitro* or *in vivo*. (These claims have been amended herein to recite the use of Compound 15 only)
- Group II:** Claims 9-25, drawn to methods of inhibiting an inflammatory response in a mammal. (These claims have been amended herein to recite the use of Compound 15 only)
- Group III:** Claims 26-30, drawn to methods of measuring the immunological activity of Compound 15 only (as amended herein).
- Group IV:** Claims 31-33, drawn to synthetic polymeric antigen Compound 15, and compositions comprising said compound.

Rationale of the Restriction Requirement

The Restriction Requirement asserts that the inventions of Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.2 because they lack the same or corresponding special technical features as they relate to multiple products and processes. The methods of Groups I, II, and III are said to be distinguished from one another in view of the specific active steps needed to be performed in order to accomplish the goal of each method, while the special technical feature of Group IV is said to be the specific chemical and immunological properties of the antigen.

Applicants' Response

Applicants respectfully submit that in view of the present claim amendments, the Lack of Unity of Invention/Restriction Requirement is improper; that the claims of Groups I - IV possess unity of invention and should therefore be examined together; and request examination of at least the claims of Groups II and IV together.

The reasoning is as follows.

Serial No.: 10/506,312
Docket No.: X-15664

Unity of Invention Practice Applicable to the Present Application

The present application entered the U.S. national stage via a PCT application. As noted in MPEP §1893.03(d), unity of invention (not restriction) practice is applicable in national stage filings under 35 U.S.C. 371, as in the present case.

Under 37 C.F.R. 1.475(b)(2), a national stage application containing claims to different categories of invention will be considered to have unity of invention if, as in the present case, the claims are drawn to a combination of categories such as a product and a process of use of said product.

Groups I – IV Possess Unity of Invention as They are Drawn to a Product (Group IV) and Processes of Use of Said Product (Groups I-III)

Annex B, Part 2 of the PCT Administrative Instructions as amended July 1, 1992, contained in Appendix A1 of the MPEP, provides examples demonstrating the proper application of the principles of unity of invention in particular cases. Category I relates to claims in different categories, as is the case for the claims of Groups I-III (methods employing Compound 15) and Group IV (Compound 15 and compositions containing the same).

Example 1 in the Annex relates to a method of manufacturing chemical substance X (claim 1), substance X (claim 2), and the use of substance X as an insecticide (claim 3). The Annex indicates that unity exists between claims 1, 2, and 3 as there is a special technical feature common to all these claims, i.e., substance X.

For the Examiner's convenience, a photocopy of the Category I examples is submitted herewith.

Applicants respectfully submit that the inventions of the claims of Groups I – IV of the present application, variously amended herein to recite only Compound 15, are analogous to the inventions illustrated in claims 2 and 3 of Example 1 in Annex B, Part 2, of the PCT Administrative Instructions as they relate to the use of a single compound (Compound 15; Group IV) in a number of methods (Groups I-III) involved in the inflammatory response.

For clarification, Applicants point out that the compound of Formula I recited in Group IV (claims 31-33) is Compound 15 as recited in all the claims of Groups I-III. Note, for example, pages 49-51 of the present specification in this regard.

Summary and Conclusions

All the method claims of Groups I-III recite the use of Compound 15, while the claims of Group IV recite either Compound 15 *per se*, or compositions containing the same which can be used in the methods of Groups I-III. Furthermore, all the method claims of Groups I-III relate to various aspects of the inflammatory response. Thus, all the claims of Groups I-IV are linked as product and processes of use of said product as in Example 1 of Annex B, Part 2 of the PCT Administrative Instructions, as well as by the phenomena involved in the inflammatory response.

Under the rules applicable to the present national stage application under 35 U.S.C. 371, because the claims of Groups I-IV share the same special technical feature, i.e.,

Serial No.: 10/506,312
Docket No.: X-15664

Compound 15, they are linked so as to form a single general inventive concept, and thus possess unity of invention. Consequently, they should therefore be examined together.

Applicants' Election

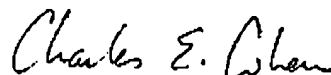
In view of the unity of invention between Groups I-IV for the reasons discussed above, applicants respectfully maintain that all the claims presented herein should be examined together. At a minimum, and in the interest of compact prosecution, the claims of Groups II (claims 9-25) and Group IV (claims 31-33) should be examined together. If necessary, the Examiner is invited to renumber the present claims by an Examiner's Amendment to facilitate examination of these two Groups together.

In the event the Examiner is not persuaded by the facts and reasoning of the analysis presented above, and so as to be fully responsive to the Examiner's Restriction Requirement, Applicants elect, with traverse, the invention of Group IV (claims 31-33) for examination.

Applicants note the Examiner's comments at pages 3-4 of the outstanding Office Action regarding rejoinder and examination of the present process claims with the product claims upon a finding of allowability of the latter, especially in view of the present amendments deleting the recitation of CP1 from the instant method claims.

If the Examiner has any questions, or would like to discuss any matters in connection with this application, he is invited to contact the undersigned at (317) 433-4983.

Respectfully submitted,



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Attachment:

Photocopy of Annex B, Part 2 of the PCT Administrative Instructions as amended July 1, 1992, Category I, contained in Appendix AI of the MPEP

ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

*[ANNEX B, CONTINUED]***PART 2****EXAMPLES CONCERNING UNITY OF INVENTION**

The application of the principles of unity of invention is illustrated by the following examples for guidance in particular cases.

I. CLAIMS IN DIFFERENT CATEGORIES**Example 1**

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

Example 2

Claim 1: A process of manufacture comprising steps A and B.

Claim 2: Apparatus specifically designed for carrying out step A.

Claim 3: Apparatus specifically designed for carrying out step B.

Unity exists between claims 1 and 2 or between claims 1 and 3. There is no unity between claims 2 and 3 since there exists no common special technical feature between the two claims.

Example 3

Claim 1: A process for painting an article in which the paint contains a new rust inhibiting substance X including the steps of atomizing the paint using compressed air, electrostatically charging the atomized paint using a novel electrode arrangement A and directing the paint to the article.

Claim 2: A paint containing substance X.

Claim 3: An apparatus including electrode arrangement A.

Unity exists between claims 1 and 2 where the common special technical feature is the paint containing substance X or between claims 1 and 3 where the common special technical feature is the electrode arrangement A.

However, unity is lacking between claims 2 and 3 since there exists no common special technical feature between them.

Example 4

Claim 1: Use of a family of compounds X as insecticides.

Claim 2: Compound X₁ belonging to family X.

Provided X₁ has the insecticidal activity and the special technical feature in claim 1 is the insecticidal use, unity is present.